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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,327	11/08/2001	Michael Alan Reeve	PA-0071	3254
7590	12/13/2004		EXAMINER [REDACTED]	DO, PENSEE T
Amersham Biosciences 800 Centennial Avenue Piscataway, NJ 08855			ART UNIT [REDACTED]	PAPER NUMBER 1641

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/007,327	REEVE, MICHAEL ALAN
	Examiner Pensee T. Do	Art Unit 1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 14 October 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-16 is/are pending in the application.  
 4a) Of the above claim(s) 4-16 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-3 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) 1-16 are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

## DETAILED ACTION

### ***Election/Restrictions***

Applicant's election with traverse of group I, claims 1-3 in the reply filed on October 14, 2004 is acknowledged. The traversal is on the ground(s) that the three groups are interrelated as to be the same invention. Applicant asserts that a broader search would not place a burden on the examiner and that the search for group III with group I since the use as claimed cannot be practiced with a materially different product for the examiner has stated that the product claim will be examined along with the elected invention. This is not found persuasive because the product can be made with another process such as spray coating instead of incubating the Fe<sub>3</sub>O<sub>4</sub> particles with a biotin-binding protein. The used as claimed can be practiced with a materially different product such as reacting the biotinylated compound with a free biotin to form a complex, attach such complex to a solid phase such as latex particles or nitrocellulose solid surface. Although it was indicated that the product will be examined with either the method of use or the method of making, Applicant did not elect either method along with the product. Furthermore, since these groups now have separate status in the art and are not used together, a search for all three groups or two groups would place a burden on the examiner. Thus, only group I, claims 1-3 are examined.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Owen et al. (US 4,795,698).

Owen teaches magnetic-polymer particles wherein the magnetic particles are magnetite ( $\text{Fe}_3\text{O}_4$ ). Such magnetic polymer particles are coated with avidin. (see col. 3, lines 24-32; claim 10).

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Ekenberg (US 5,693,784).

Ekenberg teaches an agglomeration of colloidal magnetic particles coated with streptavidin. The magnetic particles are metal oxides ( $\text{Fe}_3\text{O}_4$ ). (see col. 4, lines 61-65; col. 5, lines 60-65; claim 23).

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Rao (US 5,660,990).

Rao teaches magnetic particles coated with avidin or streptavidin. Magnetic particles behave as colloids and are prepared according to the methods of Owen (US 4,795,698). These particles are  $\text{Fe}_3\text{O}_4$ . (see col. 8, lines 45-63; col. 9, lines 1-4; col. 12, lines 16-26).

Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Terstappen (US 6,228,624).

Terstappen teaches using magnetic particles prepared by methods in US patent 4,795,698 by Owen wherein Owen teaches preparation of magnetic particles by using solution containing Fe(II) and Fe(III) and a polymer treated with a strong base in order to precipitate magnetic iron oxides such as magnetite ( $Fe_3O_4$ ) in a form which is intimately combined with the polymer. Such magnetic particles are coated with avidin or streptavidin. (see col. 2, lines 41-43; col. 3, lines 50-52).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pensee T. Do whose telephone number is 571-272-0819. The examiner can normally be reached on Monday-Friday, 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pensee T. Do  
Patent Examiner  
December 8, 2004

*Christopher L. Chin*

CHRISTOPHER L. CHIN  
PRIMARY EXAMINER  
GROUP 1800-1641

12/10/04